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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 14
EJS

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **National Auto Stores**

Serial No. 75/323,980

**Joseph M. Konieczny of Harding, Earley, Follmer & Frailey
for National Auto Stores.**

Dominick John Salemi, Trademark Examining Attorney, Law
Office 107 (Thomas Lamone, Managing Attorney).

Before Seeherman, Hohein and Chapman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

National Auto Stores has applied to register the mark
ATA and design, shown below, for "training autoparts
installers" in Class 41, and "association services, namely,
promoting the interests of automotive parts installers; and
distributorship services in the field of automotive parts"
in Class 42.¹

¹ Application Serial No. 75/323,980, filed July 14, 1997, and
asserting a bona fide intention to use the mark in commerce.

Applicant has disclaimed exclusive rights to the words AUTOMOTIVE and to SERVING THE PROFESSIONAL AUTOMOTIVE REPAIR INDUSTRY. However, the Examining Attorney has made final a requirement for the disclaimer of AUTOMITIVE TECHNICIANS ALLIANCE, rather than just the word AUTOMOTIVE in that phrase, and it is this requirement for a disclaimer that is the subject of this appeal.

The appeal has been fully briefed; an oral hearing was not requested.

Before discussing the substantive requirement for a disclaimer, there are two procedural points which we must address. In a request for reconsideration filed on February 16, 1999, along with its notice of appeal, applicant requested an amendment of the application to replace the previous disclaimer of AUTOMOTIVE and SERVING THE PROFESSIONAL AUTOMOTIVE REPAIR INDUSTRY with disclaimers of AUTOMOTIVE TECHNICIANS and SERVING THE PROFESSIONAL AUTOMOTIVE REPAIR INDUSTRY. In other words, in the phrase for which a disclaimer is at issue,

AUTOMOTIVE TECHINICIANS ALLIANCE, applicant offered a disclaimer of not just the word AUTOMOTIVE, but AUTOMOTIVE TECHNICIANS. In the next Office action the Examining Attorney stated that he was considering the disclaimer issue as it pertained to the word ALLIANCE, and maintained the requirement for a disclaimer of the entire phrase.

In its appeal brief, supplemental appeal brief,² and reply brief, applicant has stated that "whether the word 'technicians' has been disclaimed is unclear on the record." Reply brief, p. 1. Applicant apparently bases this statement on the fact that the Office records do not reflect the entry of the disclaimer; applicant also states that the Office action denying the request for reconsideration does not indicate that the amendment was entered.

Whether or not a clerical entry is made in a file or the Office's computer system is not determinative of

² As noted above, applicant filed a request for reconsideration along with its notice of appeal. It is the policy of the Board, in such situations, to institute the appeal, suspend the appeal proceeding, and remand the application to the Examining Attorney for consideration of the request for reconsideration. See TBMP § 1204. Although it is the preferred practice in such a situation that the applicant await the Board's action remanding the application to the Examining Attorney, in this case, prior to the issuance of the Board's order, applicant filed its appeal brief. Accordingly, after the Examining Attorney denied the request for reconsideration, the Board allowed applicant the opportunity to file a supplemental appeal brief.

whether a disclaimer was entered. Moreover, we think it is clear from the Examining Attorney's Office action acting on the request for reconsideration that the disclaimer of TECHNICIANS, or more specifically AUTOMOTIVE TECHNICIANS, was accepted, since the Examining Attorney treated the only issue remaining as whether the word ALLIANCE needed to be disclaimed.

However, it appears from the statements made in applicant's briefs, and specifically its arguments that TECHNICIANS is not descriptive, that it now wishes to withdraw the previously offered disclaimer of this word. An applicant should not be forced to accept a registration which it does not want, and therefore, because it appears that applicant wishes to register its mark without a disclaimer of the word TECHNICIANS, we will proceed with our decision on the assumption that the offer of this particular disclaimer has been withdrawn.

The second procedural point relates to applicant's objections to third-party registrations submitted by the Examining Attorney as part of his denial of applicant's request for reconsideration. Applicant asserts that this evidence is untimely, pointing to TMEP § 1106.07(a), which in turn refers to Trademark Rule 2.142(d). That rule provides that the record in the application should be

complete prior to the filing of the appeal. However, although in this case applicant had filed its appeal prior to the Office action, with its appeal it had filed a request for reconsideration, and, as noted previously, the Board had remanded the application to the Examining Attorney to consider the request. As part of the examination of the request for reconsideration, the Examining Attorney was entitled to submit new evidence directed to the issue of the propriety of the disclaimer of the word ALLIANCE, the remaining word in the phrase which applicant had not disclaimed. See TBMP § 1204.

This brings us to the substantive issue in this appeal. The Examining Attorney has required that applicant disclaim the entire phrase AUTOMOTIVE TECHNICIANS ALLIANCE in its mark on the ground that it is merely descriptive. Section 6(a) of the Trademark Act provides, inter alia, that "the Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable." Section 2(e)(1) of the Act prohibits the registration of marks which are merely descriptive of an applicant's goods, and Section 3 extends this provision to marks for services.

It is the Examining Attorney's position that the phrase AUTOMOTIVE TECHNICIANS ALLIANCE is merely descriptive because AUTOMOTIVE TECHNICIANS is a term of art

in the automobile repair industry and this term, when combined with the word ALLIANCE, a word similar to association or affiliation, results in a phrase which literally means an association of auto repair specialists. In support of this position, the Examining Attorney has made of record excerpts from numerous articles taken from the NEXIS database³ in which the term "automotive technician(s)" is found, including the following:

Finding a mechanic

Two out of three Americans don't trust automotive technicians, according to a recent survey by National Automotive Parts Association.

"The Indianapolis Star," July 26, 1998;

Automotive technician

Automotive repair has spun into the computer age, said Jo Erp, 39, a Dakota County Technical College graduate.

...

Erp achieved her lifelong goal of becoming an automotive technician by gaining a spot in a program sponsored by General Motors.

"Star Tribune," (Minneapolis, MN), July 12, 1998;

...technology course sponsored by Chrysler Corp. and General Motors Corp. as a successful venture. Students train to become automotive technicians in the program, which stresses on-the-job mentoring.

"Educating for Employment," June 19, 1998;

³ The search for "automotive technician" found 1434 stories. The Examining Attorney submitted the first thirty.

History turns into something like a computerized car—simple to use and impossible to fix. Automotive technicians are listed in the phone book. But who are you going to call when your history breaks down? "The New York Times," June 18, 1998;

Mr. Aaskov was an automotive technician for Performance Motors of Falmouth for several years. He traveled to Germany to attend [sic] school at the Mercedes-Benz plant... "Portland Press Herald," June 18, 1998;

Because most of us are not certified automotive technicians, when we talk to our technician about vehicle repairs, it's not unlike trying to feel knowledgeable about dealing in rocket... "Sacramento Bee," June 5, 1998; and

...turning down a pair of \$5,000 scholarships at two other colleges—to earn certification as an automotive technician. He plans to concentrate his studies toward General Motors vehicles... "The Indianapolis News," June 2, 1998.

The Examining Attorney also made of record numerous third-party registrations for marks which contain the word ALLIANCE, and in which the word ALLIANCE has been disclaimed. For example, NATIONAL AIR FREIGHT TRUCKING ALLIANCE is disclaimed in NAFTA NATIONAL AIR FREIGHT TRUCKING ALLIANCE and design for association services, namely, promoting the interests of air freight trucking companies; HOME CARE ALLIANCE is disclaimed in NORTH AMERICAN HOME CARE ALLIANCE for association services,

promoting the interests of providers and beneficiaries of home care services and products, and this registration is on the Supplemental Register, an acknowledgment that the mark as a whole is merely descriptive; INTERNATIONAL ALLIANCE OF HEALTHCARE EDUCATORS is disclaimed in INTERNATIONAL ALLIANCE OF HEALTHCARE EDUCATORS and design for association services, namely, promoting the interests of healthcare instructors; and INTELLECTUAL PROPERTY ALLIANCE is disclaimed in INTERNATIONAL INTELLECTUAL PROPERTY ALLIANCE, registered under Section 2(f), for, inter alia, educational services, namely, arranging and conducting seminars in the field of copyright protection. In addition, the Examining Attorney, in his appeal brief, quoted a definition of "alliance" as meaning "an association or union formed for the furtherance of the common interests and aims of the members."⁴ Although the submission of evidence with an appeal brief is untimely under Trademark Rule 2.142(d), we have considered such definition since the Board may properly take judicial notice of dictionary definitions. See **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 213

⁴ Webster's Third New International Dictionary, unabridged, © 1976.

USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

We also note that during the prosecution of its application applicant has provided definitions of "alliance," which include "a union, relationship, or connection by kinship, marriage, or common interest" and "a congruence of quality or type; affinity."⁵

A term is merely descriptive, and therefore unregistrable under the provisions of Section 2(e)(1), if it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature or a product or service. **In re Venture Lending Associates**, 226 USPQ 285 (TTAB 1985). See also **In re Gyulay**, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

We agree with the Examining Attorney that the phrase AUTOMOTIVE TECHNICIANS ALLIANCE is merely descriptive of the identified services, and must be disclaimed. It immediately tells consumers of these services that they involve an association directed to automotive technicians. The NEXIS evidence shows AUTOMOTIVE TECHNICIANS is a

⁵ The American Heritage Dictionary, 2d coll. ed., © 1985.

Applicant has also submitted a dictionary definition of "technician" as meaning "an expert in a technique, as: a person whose occupation requires training in a specific technical process; a dental technician; b. one who is known for skill in an intellectual or artistic technique." Id.

recognized term to refer to auto mechanics/automotive parts installers. Automotive technicians are obviously the users of applicant's training services and its association services, and the purchasers of its distributorship services. Further, the dictionary definitions submitted by applicant show that ALLIANCE describes applicant's association services, and its services of training automotive technicians, which are a union of people sharing a common vocational interest. The third-party registrations in which the word ALLIANCE is disclaimed support the descriptiveness of this word in connection with a wide variety of services, including association services, and indicate that no one party is entitled to exclusive rights to register this word.

Applicant's arguments discuss whether TECHNICIANS ALLIANCE is merely descriptive, and essentially ignore the fact that it is the entire phrase, AUTOMOTIVE TECHNICIANS ALLIANCE, which is the subject of the disclaimer requirement. Therefore, its analysis is flawed. For example, applicant argues that looking at the dictionary definitions of "technician" and "alliance," the term TECHNICIANS ALLIANCE "may suggest a union of international dental technicians." Supplemental brief, p. 4.

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Decision: The requirement for a disclaimer of AUTOMOTIVE TECHNICIANS ALLIANCE is affirmed. However, if applicant submits the required disclaimer within 30 days of the mailing date of this decision, the decision will be set aside, and the application passed to publication.

Trademark Rule 2.142(g).